

REMARKS

The application currently contains claims 123-155. Claims 123 and 155 are independent claims. No claims have been amended.

CLAIM REJECTIONS – 35 USC 102

In paragraph 2 the Examiner states that claims 123-125, 128-136, 138-139, 142-143, 144-151 and 155 are rejected under 35 USC 102(b) as being anticipated by Kimchy et al. (US 2003/0139661). In this regard, the Examiner contends that Kimchy teaches all of the elements of such claims.

Applicant respectfully traverses. Independent claim 123 requires an apparatus including the following elements to practice the claimed invention:

1. a capsule including a radiation source and a photon detector;
2. a radiopaque oral contrast agent; and
3. a control unit.

The Examiner contends that all these elements are shown by Kimchy, and specifically that a radiopaque oral contrast agent is taught by [0109-0114] and claim 79.

Applicant submits that Kimchy mentions the use of "a contrast agent" to assist in the application, however the type of contrast agent must fit the application (e.g. [0049] and [0443] long persistence ultrasound contrast agents, [0073] and [0452] magnetic resonance imaging (MRI) contrast agents, [0243] resonating at a frequency of a contrast agent). Kimchy does not teach or suggest a radiopaque oral contrast agent as part of the apparatus for practicing his invention, since the use of a radiopaque oral contrast agent would hinder the practice of Kimchy's invention. Therefore Kimchy lacks elements of claim 123 and does not anticipate the claim as suggested by the Examiner.

In Kimchy the method is based on:

1. Administration of a radiopharmaceutical to a patient. The radiopharmaceutical binds, for example to cancerous tissue in the patient's gastrointestinal tract and emits radiation. Optionally, [0470] a scintillation liquid is additionally administered to the patient, the scintillation liquid is configured to scintillate in response to radiation generated by the

radiopharmaceutical to enhance the emission (i.e. the scintillation liquid converts x-ray or gamma electromagnetic radiation into light to enhance its detection).

2. Administration of a swallowable capsule to the patient. The capsule detects the radiation emitted by the radiopharmaceutical, and/or scintillation of the scintillation liquid.

3. Reception of measurements from the capsule by an external control unit to locate abnormalities, for example cancerous growths.

Kimchy is interested in detecting the radiation emitted by the radiopharmaceutical or the scintillation resulting from it. In contrast a radiopaque oral contrast agent absorbs x-ray or gamma electromagnetic radiation and reduces the effects of the emitted radiation, thus hindering the detection of radiation and scintillation, therefore Kimchy would not use a radiopaque oral contrast agent with the other elements as currently described in applicant's invention. In the current invention in contrast to Kimchy, the detection of abnormalities is based on filling the colon with the radiopaque liquid and detection of areas with less absorption of radiation (a higher intensity of Compton backscattering of photons) since the abnormality takes up space thus less radiopaque liquid is available at those positions so the absorption is reduced (see explanation in the publication of the present application US 2007/0161885 paragraphs [0148] to [0151] and figures 2A to 2E).

The above explanation is equally applicable by similar reasoning to independent claim 155, and it is allowable for at least the same reasons. The patentability of the dependent claims follow at least for the reason of being dependent on an allowable independent claim. It should also be noted that some of the dependent claims comprise additional patentable subject matter, which is not suggested or described by Kimchy. For example, claim 124 describes that the agent has a high Z radiopaque oral contrast agent. Additionally, claims 132-134 describe that the control unit is adapted to estimate the distance based on Compton backscattering or X-ray fluorescence. In contrast, in Kimchy paragraphs [0080] to [0081] tissue analysis is done and not distance analysis and it is based on light spectroscopy, ultrasound or X-ray spectroscopy. Accordingly these claims should be indicated as allowable, even if the Examiner disagrees regarding claim 123.

CLAIM REJECTIONS – 35 USC 103

In paragraph 3 the Examiner states that claims 126-127 are rejected under 35 USC 103(a) as being unpatentable over Kimchy et al. (US 2003/0139661) in view of Sato (EP 0390478 A1).

In paragraph 4 the Examiner states that claims 137 and 140-141 are rejected under 35 USC 103(a) as being unpatentable over Kimchy et al. (US 2003/0139661) in view of Gazdzinski (US 2001/0051766).

In paragraph 5 the Examiner states that claims 152-153 are rejected under 35 USC 103(a) as being unpatentable over Kimchy et al. (US 2003/0139661) in view of Kim et al. (US 2003/0139661).

In paragraph 6 the Examiner states that claim 154 is rejected under 35 USC 103(a) as being unpatentable over Kimchy et al. (US 2003/0139661) in view of Kim et al (US 6,719,684) and further in view of Park et al. (US 2001/0038831).

In view of the above explanation regarding anticipation of claim 1 by Kimchy it is clear that Kimchy lacks at least one element of the claimed invention. The missing element is not taught by Sato, Gazdzinski, Kim or Park therefore a prima facie case of obviousness cannot be shown for the above claims as required by MPEP 2143.03.

Additionally, even if the Examiner were to provide prior art that teaches the missing element there would be no reasonable expectation of success in combining it with Kimchy to teach applicant's invention as required by MPEP 2143.02, since the missing element hinders the usage according to the teachings of Kimchy and therefore one skilled in the art could not combine the use of a radiopaque oral contrast agent to the apparatus or method described by Kimchy, without teaching how to avoid this problem.

Conclusion:

In view of the above explanation Applicant respectfully requests reconsideration of the rejections and requests allowance of all the claims.

Respectfully submitted,

MARSH FISCHMANN & BREYFOGLE LLP

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By: /Robert B. Berube/

Robert B. Berube

Registration No. 39,608

8055 E. Tufts Ave., Suite 450

Denver, Colorado 80237

Telephone: (303) 770-0051

Facsimile: (303) 770-0152